

## **REMARKS**

The application included claims 59-73 and 75, claim 74 having been previously cancelled with Applicants reserving the right to re-file the claim in a later application. The Office Action rejected claims 59-73 and 75. By this amendment, claims 59, 60, 63, 65 and 68 are amended, claims 73 and 75 are cancelled, and new claims 76-93 are added.

### **The July 27, 2007 Office Action**

Claims 59-73 and 75 were rejected under 35 USC § 251 as being based upon a defective reissue oath/declaration.

Claims 59, 67-68, 73 and 75 were rejected under 35 USC § 102 as being anticipated by Kelsey (USP 2,430,229).

Claims 59-73 and 75 were rejected under 35 USC § 103 as being obvious in light of varying combinations of Kelsey (USP 2,430,229), Miyahra (USP 4,447,677) and Killion (USP 4,677,679).

### **Reissue Declaration**

Applicants submit herewith a replacement reissue declaration in order to address the issues relating to the reissue declaration that were raised in the Office Action dated July 27, 2007. Applicants submit therefore that the rejection based upon a defective reissue oath/declaration has been overcome.

### **The Kelsey and Miyahra References**

The insert earphone of claim 59, as amended herein, includes an acoustic damper. Neither Kelsey nor Miyahra disclose or suggest an insert

earphone that includes an acoustic damper. Specifically, there is no structure in Kelsey that can be considered an acoustic damper. Further, although Miyahra includes a dust proofing sponge element 58, such a dust proofing element does not provide damping of the frequency response and, therefore, cannot be considered an acoustic damper as claimed. See Miyahra, column 4, lines 40-43; and Paragraph 4 of the Declaration of Mead C. Killion dated January 2, 2002, which was submitted previously in connection with application no. 09/489,441 and a copy of which is being submitted herewith.

The insert earphone of claim 59, as amended herein, also recites:

the insert earphone extending into and substantially acoustically sealing the ear canal of the wearer when inserted such that the insert earphone is supported by the ear of the wearer, the acoustic damper and receiver response compensating for loss of external ear resonance and coupling resonance that otherwise would occur, when the insert earphone is inserted into the ear canal of the wearer to thereby assist in providing a high fidelity response while the receiver is in close proximity to the ear canal without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member.

Neither Kelsey nor Miyahra disclose or suggest an insert earphone wherein an acoustic damper and receiver response compensates for loss of external ear resonance and coupling resonance that otherwise would occur, when the insert earphone is inserted into the ear canal of the wearer to thereby assist in providing a high fidelity response. For at least these reasons, neither Kelsey nor Miyahra, when taken alone or in combination, can anticipate or render obvious claim 59, as proposed herein.

Further, the principle of operation of the earphones disclosed in Kelsey and/or Miyahra would be changed if the earphones were modified:

(1) to include an acoustic damper, or (2) such that the response from an added acoustic damper and the receiver compensates for loss of external ear resonance and coupling resonance that otherwise would occur, when the insert earphone is inserted into the ear canal of the wearer to thereby assist in providing a high fidelity response. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” MPEP § 2143.01. Applicants submit therefore that neither Kelsey nor Miyahra, when taken alone or in combination with any other reference of record, can anticipate or render obvious claim 59, as amended herein. Applicants submit therefore that claim 59, and the claims that depend therefrom, are allowable.

### **The Killion Reference**

The insert earphone of claim 59, as amended herein, recites:

the insert earphone extending into and substantially acoustically sealing the ear canal of the wearer when inserted such that the insert earphone is supported by the ear of the wearer, the acoustic damper and receiver response compensating for loss of external ear resonance and coupling resonance that otherwise would occur, when the insert earphone is inserted into the ear canal of the wearer to thereby assist in providing a high fidelity response while the receiver is in close proximity to the ear canal without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member.

As claimed, the insert earphone, which includes a housing, extends into and substantially acoustically seals the ear canal of the wearer when inserted such that the insert earphone is supported by the ear of the wearer. However, the housing (base unit 2) taught by Killion cannot be supported

by the ear of a wearer. Further, in the Killion system, the receiver/transducer 21 is not in close proximity to the ear canal when the system is in use. Also, as described in previous Office Action responses, the Killion system requires a long flexible tube (sound tube 7) between the housing (base unit 2) and the ear piece 8 in order to provide a high fidelity response. For at least these reasons, Killion, when taken alone, cannot anticipate or render obvious claim 59, as proposed herein.

Further, because the Killion system requires a long flexible tube (sound tube 7) between the housing (base unit 2) and the ear piece 8 in order to provide a high fidelity response, Killion teaches away from the claimed configuration, wherein the acoustic damper and receiver assist to provide a high fidelity response while the receiver is in close proximity to the ear canal without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02. Because the Killion reference teaches away from using the claimed configuration to provide a high fidelity response, Killion cannot be used to render an earphone that provides a high fidelity response using the claimed earphone configuration obvious.

### Combination of References

Applicants' application cannot be used as a roadmap to combine prior art references. “The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention[.]” MPEP § 2141. As discussed above, modifying the earphones of Kelsey and/or Miyahra to include the claimed elements would change the principle of

operation of the earphones. Such modification is improper in the obviousness context. Also, the Killion reference teaches away from configuring an earphone in the claimed manner to provide a high fidelity response. The Killion reference therefore cannot be used to render an earphone that provides a high fidelity response using the claimed earphone configuration obvious. Applicants submit therefore that Kelsey, Miyahra and/or Killion, when taken together or with any of the other references of record, cannot anticipate or render obvious claim 59, as amended herein. Applicants submit therefore that claim 59, and the claims that depend therefrom, are allowable.

## **New Claims**

Applicants submit that new claims 78-93, which are directed to a dual earphone assembly are fully supported in the application. New Claim 78 recites a dual earphone assembly that includes “a pair of insert earphones configured to produce high fidelity stereophonic reproduction based on the output of a stereophonic amplifier and substantially acoustically seal both ears of a wearer . . . .” Support for this claim is present in the application, for example, in FIG. 1, which “illustrates a high fidelity insert earphone assembly of the invention” (Application, Brief Description Of The Drawings, page 4, lines 27-28 (emphasis added)), and in the following portions of the application, which state:

In accordance with the invention, an audiophile insert earphone is provided which uses a damped coupling assembly similar to that disclosed in the above-mentioned Killion and Murphy paper and operative to provide compensation for the loss of external-

ear resonance. In accordance with one important feature of the invention, a pair of such earphones are combined in a dual earphone assembly usable for stereophonic reproduction.

\* \* \*

The illustrated assembly 10 includes a pair of earphones 11 and 12 for insertion into the entrances of the ear canals of a user. A pair of cables 13 and 14 connect earphones 11 and 12 to a junction unit 15 and a common cable 16 connects the junction unit 15 to a plug connector 17 which may be connected to an output jack of a stereophonic amplifier, for example.

(Application, Summary Of The Invention, page 3, lines 20-27 and Application, Description Of A Preferred Embodiment, page 5, lines 24-30 (emphases added).) Applicants submit therefore that new claim 78 and claims that depend therefrom are fully supported in the application.

New Claim 78 recites an insert earphone assembly that includes “a pair of insert earphones configured to produce high fidelity stereophonic reproduction based on the output of a stereophonic amplifier and substantially acoustically seal both ears of a wearer”. None of the references relied upon in the Office Action dated July 27, 2007 (Kelsey, USP 2,430,229, Miyahra, USP 4,447,677, and Killion, USP 4,677,679) teach or suggest a pair of insert earphones configured to produce high fidelity stereophonic reproduction and substantially acoustically seal both ears of a wearer. Applicants submit therefore that new claim 78 and claims that depend therefrom cannot be anticipated or rendered obvious by any of the cited references, whether taken alone or in combination.

Further, new claim 78 also includes limitations similar to those discussed above in connection with independent claim 59. For the same

reasons discussed above in connection with independent claim 59, Applicants submit that new claim 78 and claims that depend therefrom cannot be anticipated or rendered obvious by any of the cited references, whether taken alone or in combination.

### **Previous Papers, Official Notice and Indicia of Non-Obviousness**

The Office previously rejected the previously pending claims under 35 USC § 103 as being obvious in light of varying combinations of McCabe (USP 3,671,685), Miyahra (USP 4,447,677), Killion (USP 4,677,679) and Kelsey (USP 2,430,229).

In its July 25, 2005 response, Applicants provided a detailed explanation as to why the previously pending claims are patentable over these references. At the heart of Applicants' argument is that the combination of references cited in the Office Action does not teach, among other things, "the earphone providing a high fidelity response without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member."

On January 26, 2006, the Office issued a second rejection. In this rejection the Office again reiterated that none of the references "teach that the earphone provides a high fidelity response as claimed." However, the Office claimed connecting a hearing aid to a circuitry or an amplifier for providing an output signal with relatively high fidelity was known in the art. The Office Action, however, provided no support for this position. And while the Examiner obviously completed a thorough and detailed search of the

prior art, the Examiner's search did not yield a single reference that the Examiner could cite to for this proposition. Moreover, because the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known," Applicants assert that the Examiner cannot take official notice of this fact under MPEP 2144.03. Accordingly, the Applicants requested that the Office provide a reference(s) to support the Office's position if the Office intends to maintain any rejection based on the assertion.

The November 3, 2006 and July 27, 2007 Office Actions reiterated the Office's above-described position without providing a reference(s) to support that position. For all the reasons above, Applicants again request that the Office provide a reference(s) to support the Office's position if the Office intends to maintain any rejection based on the official notice assertion.

Moreover, the Office has apparently ignored Applicants' submissions regarding non-obviousness. One important indicator of the non-obviousness of an invention is the failure of others to achieve the invention. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 U.S.P.Q. 459 (1966). The Applicants are believed to be the first to have successfully designed and built a high-fidelity insert earphone. The Applicants' unique combination of elements compensates for loss of external ear resonance and results in an earphone that achieves high fidelity reproduction. To Applicants' knowledge, none of the prior art references, either alone or in combination, achieve high fidelity reproduction as does Applicants' invention.

Another important indicator of the non-obviousness of an invention is praise of the invention by experts. See, e.g., *Litton Systems Inc. v. Honeywell, Inc.*, 39 U.S.P.Q.2d 1321, 1327 (1996). As evidenced by the reviews previously submitted, Applicants' invention has been met with high praise from experts in the audio industry. In fact, many experts believe that Applicants' earphones are perhaps the best available on the market and succeed where many others have failed.

Clearly such evidence further demonstrates the non-obviousness of Applicants' invention and supports allowability of the pending claims. The Office, however, never addressed, and thus apparently never gave any weight to, Applicants' evidence of non-obviousness. Applicants request reconsideration of the pending claims in light of this evidence.

### **Conclusion**

In view of the foregoing, it is respectfully submitted that the pending claims define allowable subject matter over the art of record. The Office is invited to come forth with additional references that provide support for its rejections. However, if unable to do so, Applicants respectfully request that the Office withdraw its rejections.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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